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**REMARKS**

Claims 1-12 and 21 are pending in the present application. In response to Applicant's amendment submitted March 1, 2005, the prior rejection was withdrawn and the current Office Action sets forth the following new grounds for rejection.

Claim 1 was rejected under 35 U.S.C. §103(a) over Reilly et al., US Patent No. 5,740,549 filed 6/12/1995 (hereinafter Reilly) in view of Chui et al., US Patent No. 6,549,674 (herein after Chui). Dependent claims 2 and 5 – 8 were also rejected under 35 U.S.C. §103(a) over Reilly in view of Chui, and although separately set forth in the Office Action the rejection is traversed below in conjunction with independent claim 1. Claim 9 was rejected under 35 U.S.C. § 103(a) over Reilly in view of Chui, and further in view of Mitchell et al. US Patent No. 5,963,966 filed 11/08/1996 (hereinafter Mitchell), and Kojima US Patent No. 6,081,277 filed 09/25/1996 (hereinafter Kojima). Dependent claims 3-4, 10-12 and 21 were also rejected under 35 U.S.C. §103(a) over Reilly in view of Chui, and further in view of Mitchell and Kojima, and although separately set forth in the Office Action, the rejection is traversed below in conjunction with independent claims 1 and 9.

**A. Rejection under 35 U.S.C. §103(a) over Reilly in view of Chui**

Independent claim 1, and dependent claims 2, 5, 6, 7, 8 have been rejected under 35 U.S.C. §103 as being unpatentable over Reilly in view of Chui. This rejection under 35 U.S.C. §103 over Reilly in view of Chui is respectfully traversed.

In reference now to independent claim 1, in formulating the rejection under 35 U.S.C. §103, the Examiner has correctly noted that Reilly teaches an on-line newspaper publishing system for preparation of one or more publications and teaches a networked host server. The Examiner also correctly notes that Reilly teaches "image files." The Examiner has also correctly noted that Chui teaches the use of anti-aliasing.

As the basis for the combination of Reilly and Chui, the Examiner has alleged that the teachings of Reilly suggest such a combination (col. 1, line 35 – col. 2, line 60), where the mixing of advertising and information content. However, other than the limitations of the rejected claims, Applicant is unable to locate a teaching or suggestion in Reilly that would suggest the combination with or use of image compression or anti-

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aliasing as taught by Chui, let alone use for producing reduced-size preview images for displayed advertisements. Absent such teaching or suggestion of modification to support the proposed combination, Applicant respectfully urges that Reilly and Chui are not properly combined, and that *prima facie* obviousness has not been established.

Considering the combination, *in arguendo*, although Reilly teaches image files it is not apparent what teaching the Examiner has relied upon in alleging that Reilly teaches "images of full-size display advertisements and corresponding reduced-size preview images" as recited in claim 1. At col. 13, lines 9 – 25, Reilly indicates that an advertisement is stored as a GIF image, but there does not appear to be any suggestion that both full-size display advertisements and reduced-size preview images are stored. Moreover, a straight forward reading of Reilly would appear to teach away from the recited limitations, where it is clear that the advertisement of Reilly serves as a link to the advertiser (col. 13, lines 21-25; col. 14, lines 7 – 11), rather than a link to an associated full-size display advertisement as set forth in claim 1.

The Examiner alleges that Reilly teaches a composition computer connected to said host server; and an image database, associated with the server and accessible by the composition computer, that defines at least the following, content to be prepared for publication in a digital edition hosted on the host server. This position and conclusion by the Examiner is respectfully traversed.

It is noted that the composition computer of Reilly cannot be a separate machine attached to said host server, because the composition computer of Reilly and the host server are the same machine. Reilly does not suggest or teach a separation between the composition computer and the host server.

In contrast, claim 1 recites a composition computer connected to a host server. This configuration is set forth in the instant application where the connection is described as the Internet (Page 9, lines 2-5 and Page 9, lines 14-30, Page 11, lines 11-19). It is noted that in order for data transfer to take place between two computers such as a composition computer of the present invention and the host server of the present invention, software for Internet communication must be in operation in both the composition computer and the host server to facilitate that transfer. The use of a separate composition computer and associated software for the purpose editing or

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composing content on the host server is absent from the teachings of Reilly. Reilly only teaches a one-way information flow through the Internet, from the host server, to disseminate the content to consumers of that content.

It is noted that using a connection between composition computers and the host server provides a desirable flexibility that enables personnel who edit or compose content to work at locations remote from the host server, requiring only conventional Internet communication software. The teachings of Reilly, on the other hand, require personnel to use the host server directly at its singular location.

In further reference to independent claim 1, the Examiner alleges that Reilly teaches "at least one layout template wherein the template defines at least a region on a web page for the display of a preview image of a display advertisement." This position and conclusion by the Examiner is respectfully traversed.

It is noted that the special display software of Reilly is not a conventional Internet browser, rather special software that can only be used to display the information and advertisements of Reilly that are under the control of the special software of Reilly on the host server. Therefore because Reilly does not compose conventional web pages, Reilly does not provide a layout template that defines a region on a conventional web page for display of a preview advertisement.

Although Reilly provides a link to the web pages of advertisers, accessing such a link, in Reilly, invokes a web browser separate from the special display software of Reilly to display information entirely outside the control of the software of Reilly from a web server which is not part of the special display software of Reilly. It is noted that this process of Reilly is not the same as composing a conventional web page by assigning content to a "layout template wherein the template defines at least a region ... for display of a preview image of a display advertisement" on a conventional web page.

In the rejection the Examiner further alleges that Reilly teaches "browser-readable code representing a web page, wherein the web page has at least one link to an image file and wherein the corresponding reduced-size preview images have been produced by the application of an anti-aliasing filter to the full-size display advertisements" as recited in claim 1. This position and conclusion by the Examiner is respectfully traversed.

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As has been noted above, the special display software of Reilly is not a conventional Internet browser, but rather special software that can only be used to display the information and advertisements of Reilly that are under the control of the special software of Reilly on the host server. Therefore, since the information of Reilly can only be read by the special display software of Reilly, Reilly does not provide browser-readable code representing a web page that can be read or used by a conventional Internet browser.

Nor does Chui teach or suggest the use of the image processing system to produce reduced-size preview images from full-sized advertisement display images. Accordingly, even considering the arguable combination of Reilly and Chui, the combination fails to teach all of the elements recited in rejected claim 1. Claim 1 is, therefore, patentably distinguishable over the arguable combination.

In summary, in reference to independent claim 1, the arguable combination of Reilly in view of Chui fails to teach, suggest or render obvious "a composition computer connected to said host server; and an image database, associated with the server and accessible by the composition computer, that defines at least the following, content to be prepared for publication in a digital edition hosted on the host server;" or "images of full-size display advertisements and corresponding reduced-size preview images;" or "at least one layout template wherein the template defines at least a region on a web page for the display of a preview image of a display advertisement" or "browser- readable code representing a web page, wherein the web page has at least one link to an image file and wherein the corresponding reduced-size preview images have been produced by the application of an anti-aliasing filter to the full-size display advertisements" as set forth in independent claim 1.

With respect to dependent claims 2, 5 and 8, the Applicant, for the sake of brevity, will not address the reasons supporting patentability for these individual dependent claims, as these claims depend directly from allowable independent claim 1. The Applicant reserves the right to address the patentability of these dependent claims at a later time, should it be necessary.

In reference now to dependent claims 6 and 7, in formulating the rejection under 35 U.S.C. §103, the Examiner alleges that Reilly teaches "the preview images are

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periodically moved relative to one another on the web page” and “the location of the preview images is determined as a function of the category of the web page.” This position and conclusion by the Examiner is respectfully traversed.

As has been noted above, the special display software of Reilly is not a conventional Internet browser, but is, rather, special software that can only be used to display the information and advertisements of Reilly that are under the control of the special software of Reilly on the host server. Although Reilly teaches the altering of positions of headlines within the special data viewer of Reilly and within a special screen saver (Column 5, lines 5-33), the advertisements are not characterized as moving or altering position (in contrast to the claimed invention, Reilly only depicts a single advertisement on a page; col. 13, line 61 – col. 14, line 6). Moreover, Applicant urges that this does not give rise to a teaching of moving preview images relative to one another (claim 6), or determining location as a function of category (claim 7).

Accordingly, in view of the remarks set forth above, the Examiner is respectfully requested to reconsider and withdraw the rejection of independent claim 1 and dependent claims 2 and 5 - 8 under 35 U.S.C. §103.

**B. Rejection under 35 U.S.C. § 103(a) over Reilly in view of Chui and further in view of Mitchell and Kojima.**

In reference now to the rejection of independent claim 9, Applicant respectfully incorporates the above-noted traversal of the combination of Reilly and Chui, including both the objection to the proposed combination as well as the noted distinctions.

In formulating the rejection of claim 9 under 35 U.S.C. §103, the Examiner correctly noted that independent claim 9 incorporates substantially similar subject matter as cited in claim 1. The Examiner declares that independent claim 9 is similarly rejected along the same rationale. However, in view of allowable claim 1, Applicant respectfully requests the Examiner to withdraw the rejection of independent claim 9 on that basis.

The present rejection relies upon a further combination of Mitchell and Kojima. It is noted that in *Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal, Inc.*, 231 F.3d

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1339, 56 USPQ2d 1641 (Fed. Cir. 2000), from *In re Rouffet*, 149 F.3d 1350, 1357-58, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998 (internal citations omitted):

As this court has stated, "virtually all [inventions] are combinations of old elements." Therefore, an examiner [or accused infringer] may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner [or accused infringer] to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.

The Examiner urges, at the top and bottom of p. 5 of the Office Action, that it would have been obvious to make the proposed combination, but again mistakenly relies on Reilly as suggesting the combination. Furthermore, there is no specific indication as to the teaching or other basis relied upon for combining Mitchell with Reilly or Chui. And, it appears that the basis for combining the teachings of Kojima are the result of its indication of the display of a frame of an image in a restricted display area – even though Kojima relates to "an image display controller and an image display control method..." (col. 1, lines 6-10). Absent specific teaching in the references themselves, it appears that the various limitations of the rejected claim have been used as the "recipe" by which the elements of unrelated patents are combined for the rejection. Applicant respectfully contends that this is not an appropriate basis for an obviousness rejection, and respectfully urges that the combination of Reilly, Chui, Mitchell and Kojima is improper and that *prima facie* obviousness has not been established.

Although Reilly teaches an "information and advertising distribution system and method," Reilly does not teach the use of a conventional browser as the means for displaying the information under the control of Reilly. As has been noted above, Reilly uses special display software which is not a conventional browser, but rather special software that can only be used to display the information and advertisements of Reilly that are under the control of the special software of Reilly on the host server. The

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teachings of Chui (Column 11, lines 17-67, Column 12, lines 1-21), Mitchell (Abstract) are each specifically directed to the use of a conventional Internet browsers for the display of the information and images under the control of each. The teachings of Kojima (Column 4, lines 6-39) are not directed to an "on-line newspaper publishing system" but are specifically directed to the collection and reconstruction of an image from any location whatsoever on the Internet, retrieved from a conventional Internet server executing conventional Internet server software, accessed via conventional Internet navigation by an individual user of the Internet on the computer being used by that individual. Thus, there does not appear to be any teaching or suggestion of the proposed combination or modification, and the rejection is respectfully traversed as being improperly based upon Applicant's claims.

Considering the combination of Reilly, Chui, Mitchell and Kojima, *in arguendo*, the Examiner has correctly noted that Reilly and Chui do not teach creating "digital copy from a print media source." Mitchell is alleged to provide a teaching of "collecting advertiser digital copy from a print media source." However, Applicant can find no teaching or suggestion of the use of the Mitchell document processing system with newspapers or advertising. Accordingly, it would appear that the teachings of Mitchell have been improperly broadened to allege teaching of the collection of advertiser copy from print media as recited in claim 9. Applicant urges, therefore, that the arguable combination of Mitchell fails to teach the recited limitation, and that claim 9 is patentably distinguishable and in condition for allowance.

With continued reference to the rejection of claim 9, Kojima is alleged as teaching a reduced-size preview image of advertiser copy and associating text based content with a preview image. Yet, no teaching has been identified for the claimed limitation that "the preview image is a selectable object that is linked to a full-size image of the advertiser copy..." as set forth in claim 9. Absent such a teaching, the arguable combination further fails to provide an adequate basis for a rejection under 35 U.S.C. § 103(a), and that claim 9 is in condition for allowance.

In summary, the arguable combination of Reilly, Chui, Mitchell and Kojima, whether taken in any arguable combination or taken separately, fail to teach, suggest or render obvious "A method of preparing an on-line news publication ... including ...

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collecting advertiser digital copy from a print media source; creating, using an image size reduction operation that includes an anti-aliasing filter, a reduced-size preview image of the advertiser digital copy, wherein at least one dimension of the preview image is determined in accordance with a predetermined size; associating text-based content with the preview image in a web page, wherein the preview image is a selectable object that is linked to a full-size image of the advertiser copy....” as set forth in independent claim 9. Accordingly, in view of the remarks set forth above, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. §103 and to indicate the allowance of claim-9.

With respect to the rejection of dependent claims 3 and 4, Applicant respectfully maintains that the Examiner has failed to set forth an appropriate rejection, and that the finality of the Office Action is therefore premature. As noted by the Examiner, claims 3 and 4 depend from claim 1, yet the rejection of claims 3 and 4 was not based upon a rejection of system claim 1, but on method claim 9. Applicant respectfully requests that in the event that the rejection of claims 3 and 4 is maintained, that a subsequent Office Action set forth the basis for such a rejection in a manner in which Applicant can respond. Accordingly, Applicant reserves the right to address the patentability of these dependent claims at a later time, should it be necessary.

With respect to dependent claims 10 and 21, the Applicant, for the sake of brevity, will not address the reasons supporting patentability for these individual dependent claims, as these claims depend directly from allowable independent claim 9. The Applicant reserves the right to address the patentability of these dependent claims at a later time, should it be necessary.

In reference now to claim 11, the Examiner alleges that Reilly teaches the limitations of claim 11. However, although Reilly does teach the graphics interchange file format (.gif), such a teaching does not give rise to the recited limitation of “digitizing advertiser hard copy” as recited in claims 10 and 11. Accordingly, the rejection of claim 11 is respectfully traversed.

With respect to dependent claim 12, this claim depends directly from allowable independent claim 9. Claim 12 adds the limitation that the aspect ratio is maintained to facilitate placement of dissimilarly sized advertisements in locations having a common



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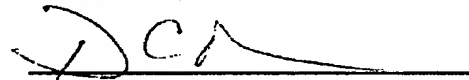
dimensional limitation. Not only does the cited portion of Kojima not teach the limitation, the noted adjustment of at least one of the lengths would seem to teach away from recited maintenance of the aspect ratio. Accordingly, the rejection of claim 11 is respectfully traversed.

In view of the arguments in traversal of the rejections set forth above, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 9 and claims 3-4, 10-12 and 21 under 35 U.S.C. §103.

In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited. In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 50-2737 for Basch & Nickerson LLP.

In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,



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